

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: **Shoji HARA et al.**

Group Art Unit: **1762**

Application Number: **09/782,169**

Examiner: **Brian K. Talbot**

Filed: **February 14, 2001**

Confirmation Number: **2107**

For: **LAMINATE COMPRISING POLYIMIDE AND CONDUCTOR  
LAYER, MULTI-LAYER WIRING BOARD WITH THE USE OF  
THE SAME AND PROCESS FOR PRODUCING THE SAME**

Attorney Docket Number: **010164**  
Customer Number: **38834**

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

April 9, 2008

Sir:

This paper is filed in response to the Notice of Non-Compliant Appeal Brief dated March 31, 2008.

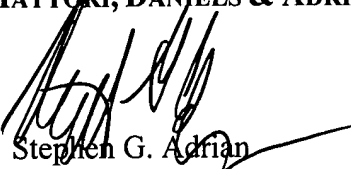
This Notice indicated that another copy of the declarations was not attached to the Evidence Appendix. Although a copy of the declarations was filed with the Appeal Brief filed November 14, 2007, another Appeal Brief is submitted herewith with another copy of the declarations requested by the Examiner.

The Examiner's attention is directed to MPEP §1205.03(B) which states that an entire new brief need not, and should not, be filed when a brief is considered defective due to appellant's failure to provide a summary of the claimed subject matter under 37 CFR §41.37(c) (1)(v). Another copy of the entire brief, however, is submitted herewith in order to expedite a decision on appeal.

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF  
Attorney Docket No. 010164  
Serial No. 09/782,169

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Respectfully submitted,  
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Enclosures: Appeal Brief



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

APPEAL BRIEF FOR THE APPELLANT

Ex parte Shoji HARA et al. (Applicant)

LAMINATE COMPRISING POLYIMIDE AND CONDUCTOR LAYER, MULTI-LAYER  
WIRING BOARD WITH THE USE OF THE SAME AND PROCESS FOR PRODUCING THE  
SAME

Application Number: 09/782,169

Filed: February 14, 2001

Appeal No.:

Group Art Unit: 1762

Examiner: Brian K. Talbot

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**April 9, 2008**

Revise Appeal Brief  
Attorney Docket No. 010164  
Application No. 09/782,169



**BRIEF ON APPEAL**

**(I) REAL PARTY IN INTEREST**

The real party in interest is **KANEKA CORPORATION**, by an assignment recorded in the U. S. Patent and Trademark Office on May 21, 2001, at Reel 011827, Frame 0305.

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Attorney Docket No. 010164  
Application No. 09/782,169

**(II) RELATED APPEALS AND INTERFERENCES**

There are no other applications, patents, appeals or interferences known to appellant, appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Revise Appeal Brief  
Attorney Docket No. 010164  
Application No. 09/782,169

**(III) STATUS OF CLAIMS**

Claims 1-13 and 17-20 are pending. Claims 14-16 have been canceled. Rejected claims 1-13 and 17-20 are appealed. The appealed claims appear in the appendix.

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Attorney Docket No. 010164  
Application No. 09/782,169

**(IV) STATUS OF AMENDMENTS**

No amendments have been filed subsequent to final rejection.

**(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**

The invention is directed to processes for producing a laminate comprising a polyimide and a conductor layer. As set forth in the independent claims (described in more detailed below), the claimed processes are characterized in that at least one conductor layer is directly formed on a surface of a thermoplastic polyimide film to obtain a laminate. In other words, a conductor layer is directly formed (for example, by plating, sputtering, evaporation, CVD or ion plating), on a thermoplastic polyimide film. The claimed processes differ from methods which employ a previously formed conductor layer (a foil) which is laminated to polyimide.

As recognized in the art, polyimide films show only poor adhesion strength to conductor layers. Thus, to improve adhesion, it has been a practice to mechanically roughen the surface by sandblasting in order to enlarge the contact area of a conductor layer or to employ an undercoating layer prior to formation of a conductor layer on a polyimide film (see specification, page 2, lines 1-9). Such methods suffer various problems.

The present inventors discovered that, in a laminate wherein a metallic layer is directly formed on a thermoplastic polyimide, there has still existed a margin for the strength of the adhesive layer to increase. In other words, the present inventors discovered that the strength has not reached the maximum value yet, and that intentional heating of the laminate can give rise to an improved result.

Various techniques for forming a metallic layer directly on a thermoplastic polyimide are well known, and the resulting laminates, which have been prepared by some metallic layer



formation process depending on each application, are in practical use without serious problems. Those of ordinary skill would naturally think that the maximum adhesion strength has already been achieved. Accordingly, it is almost impossible to envisage any further treatment for adhesion enhancement.

The present inventors discovered that adhesion strength can be unexpectedly improved when a conductor layer is formed directly adhering with a thermoplastic polyimide and then subsequently heated after the laminate is formed. See the data provided in the specification and the attached declarations of Masaru Nishinaka filed on July 11, 2003 and on March 2, 2005.

#### **Independent Claim 1**

Claim 1 is directed to a process for producing a laminate comprising a polyimide and a conductor layer. The method comprises forming at least one conductor layer directly adhering to at least one surface of a thermoplastic polyimide film to obtain a laminate, and heating said laminate after said laminate is formed so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced.

Thus, claim 1 requires at least one surface of a thermoplastic polyimide film upon which a conductor layer is formed directly adhering thereto. The language of claim 1 does not read on and is not intended to read on metal foils which are previously formed and then applied to a thermoplastic polyimide film. See the paragraph bridging pages 11 and 12 of the specification.

**Independent Claim 2**

Independent claim 2 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. The process comprises casting or applying a polyamic acid corresponding to a thermoplastic polyimide to at least one of a sheet material surface (page 11, lines 1-9), imidating said polyamic acid to form a polyimide laminate having a thermoplastic polyimide surface (page 11, line 7-9), forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces to obtain a laminate (see paragraph bridging pages 11 and 12 of the specification), and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced (page 12, lines 10-14). Thus, similar to claim 1, claim 2 requires the initial formation of a thermoplastic polyimide surface, followed by forming at least one conductor layer directly adhering with the thermoplastic polyimide surface, followed by heating to enhance adhesion strength.

**Independent Claim 3**

Independent claim 3 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. The process of claim 3 requires attaching at least one thermoplastic film to at least one of a sheet material surface to form a polyimide laminate having thermoplastic polyimide surface(s) (page 11, lines 1-5), forming at least one

conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces (page 11, line 16 through page 12, line 10), and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced (page 12, line 10 to page 13, line 7). Thus, similar to claims 1 and 2, claim 3 also requires the formation of a thermoplastic polyimide surface upon which a conductor layer is formed directly adhering thereto, followed by heating so that adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced.

**Dependent Claim 12**

Claim 12 depends from claim 10, which in turn depends from any one of claims 1 to 3a(page 11, line 17). Claim 10 requires that the conductor layer is formed by a dry plating method, and claim 12 requires further increasing the total thickness of the conductor layer by a wet plating method (page 11, line 23 to page 12, line 5).

**Independent Claim 17**

Independent claim 17 is directed to a process for producing a laminate. The process requires dry plating (page 11, line 17) at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate, and heating said laminate so that the adhesive strength between the thermoplastic polyimide film and the conductor layer is enhanced (page 12, lines 10 through page 13, line 7). Thus, as with the other independent

claims, claim 17 requires the presence of a thermoplastic polyimide film on which a conductor layer is directly adhered thereto. Claim 17 is specific to forming the conductor layer by dry plating.

**Independent Claim 18**

Independent claim 18 is directed to a process producing a laminate. The process requires providing a thermoplastic polyimide film having at least one surface (page 11, lines 1-9); forming a conductor layer directly adhering with said at least one surface (page 11, line 16 to page 12, line 10); and heating the thermoplastic polyimide film and the formed conductor layer (page 12, line 10 to page 13, line 7). Thus, as with the other independent claims, claim 18 requires the presence of a thermoplastic polyimide film upon which a conductor layer is formed directly adhering with at least one surface thereof. Claim 18 further requires heating the thermoplastic polyimide film and the formed conductor layer.

**(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following rejections are presented for review.

1. Claims 1-9, 13 and 17-20 being rejected under 35 USC §103(a) as being unpatentable over Chen et al. or Shiotani et al. in combination with JP54-066966.
2. Claims 1, 3-11, 13 and 17-20 being rejected under 35 USC §103(a) as being unpatentable over JP '640 or JP '106 in combination with JP '966.
3. Claim 12 being rejected under 35 USC §103(a) as being unpatentable over JP '640, Chen et al., Shiotani et al. or JP '106 in combination with JP '966 further in combination with Ameen et al.

**(VII) ARGUMENT**

**1. Claims 1-9, 13 and 17-20 are patentable over Chen et al. or Shiotani et al. in combination with JP54-066966.**

The combination of references set forth in the rejection fails to raise a prima facie rejection of the claims because the combination does not teach all of the features required by the claims. Furthermore, the combination provides no suggestion which would render the claimed invention obvious.

**Independent Claim 1**

The combination of references fails to teach the features required by claim 1 with respect to forming at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate, and heating said laminate after said laminate is formed so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced.

In the final Office Action dated February 15, 2007, the Examiner applied the teachings of Chen et al. or Shiotani et al. with respect to applying a metal layer to a polyimide layer. The final Office Action acknowledged that Chen et al. and Shiotani et al. each fail to teach heating the laminate. JP '966 was applied by the Examiner for its disclosure of aging which does not result in reduced adhesion strength. The Examiner argued that it would have been obvious to modify

the teachings of Chen et al. or Shiotani et al. to perform a subsequent aging step “with the expectation of achieving a superior bond between the polyimide and the metal layers.”

The Examiner’s rationale for combining the references “with the expectation of achieving a superior bond between the polyimide and the metal layers” is unsupported by the teachings of the references. As argued in the Request for Reconsideration filed on June 28, 2007, JP ‘966 does not teach what the Examiner asserts. Quite the contrary, JP ‘966 teaches the opposite. JP ‘966 does not describe that ‘the ripening step can prevent the decrease in the adhesion strength’ but suggests that the ripening may cause a decrease in the adhesion strength, but the ripening in an inert atmosphere could prevent the decrease in the adhesion strength. It should be considered that the ripening does not cause the decrease in the adhesion strength but the use of inert gas avoids the occurrence of decrease in the adhesion strength, and still it can merely maintain the adhesion strength at an originally present level. The purpose of ripening in JP ‘966 is in suppressing the curl, and there cannot be found a suggestion that the ripening increases the adhesion strength. In particular, Example 1 of JP ‘966 teaches that adhesion strength was reduced by about 20% compared with that prior to heat aging. This teaching would teach away from use of heat aging in Chen et al. or Shiotani et al.

In the Advisory Action dated September 14, 2007 (almost three months after the request for reconsideration after final rejection was filed), the Examiner noted that JP ‘966 recites a drying-solidification step as well as the ripening step. The Examiner asserted in the Advisory Action that this drying-solidification step would increase adhesion of the polyimide and metal

layer. The Examiner does not explain the basis for this conclusion as it relates to the claimed invention. The Advisory Action further argues that because JP '966 provides sections which do not mention a reduction of adhesion, the failure of the claims to recite a particular increase in adhesion would encompass a small increase.

JP '966 is directed to a method which comprises cast-coating, on a metal foil, a solution of a heat-resistant polymer, a polyimide precursor solution, or a polyester-imide solution, then solidifying the solution via drying, and thereafter executing a ripening for a prolonged period. Thus, instead of directly forming a metal on a thermoplastic polyimide as required by the present claims, JP '966 is directed to forming a plastic layer on a metal foil. As such, the Examiner's position that the drying-solidification step would increase adhesion is misplaced as applied to the present claims. That is, claim 1 requires forming at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate. In the drying-solidification step of JP '966, a laminate of polyimide layer/conductor layer is yet to be obtained. Even if it is assumed as asserted by the Examiner that there would be some increase of adhesion, the teachings of JP '966 combined with Chen et al. or Shiotani et al. still would fail to teach the claimed invention. In other words, in the drying-solidification step of JP '966, there is yet to be provided a laminate of polyimide layer/conductor layer.

Claim 1 is further distinguished from the cited references by requiring heating said laminate after said laminate is formed so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced. It is the Examiner's position that because



the claims do not recited a “particular” increase, such would encompass a small increase. As noted above, claim1 requires heating said laminate after said laminate is formed so that the adhesion between the thermoplastic polyimide film and the conductor layer is enhanced. Accordingly, the solidifying/drying step of JP ‘966 can not read on this step because there is yet to be a laminate (the laminate having a conductor layer directly adhering with at least one surface of a thermoplastic polyimide film). Therefore, the only possible teaching which may be applicable to claimed heating step would have to correspond to the ripening step of JP ‘966. The ripening step of JP ‘966 in no way teaches or suggests that adhesion strength is enhanced, but instead teaches away from any increase. Even if it is considered that no reduction in adhesive strength occurs in JP ‘966, there is still no teaching of an enhanced adhesion strength required by claim 1. Therefore, the combined teachings of the references fail to teach all the limitations required by claim 1.

It should be noted that the teachings of the references all relate to use of a metal foil as opposed to forming at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film. For example, Shiotani et al. is directed to a polyimide/metal composite sheet composed of a polyimide substrate film and a metal foil. Similarly, Chen et al. teaches an improved method of laminating a metal foil or sheet to a polyimide material. The only mention of plating appears to be in the discussion of the prior art made by Shiotani et al. at column 1, lines 29 and 30, which mentions that one known method is a metal electrically plated onto a polyimide film. Accordingly, appellants respectfully argue that the combination of the

teachings of the references would not fairly direct one of ordinary skill in the art to form at least one conductor layer directly adhering to at least one surface of a thermoplastic polyimide film to obtain a laminate. That is, a fair reading of the cited art would not have motivated one of ordinary skill in the art to form a conductor layer directly adhering of at least one surface of a thermoplastic polyimide film (for example by plating), following by heating to enhance the adhesion strength. Instead, the teachings of the prior art would motivate one of ordinary skill in the art to employ a metal foil as all of the cited references exemplify. Since the references would have motivated one of ordinary skill in the art to employ a metal foil, the references fail to teach the required limitation of forming at least one conductor layer directly adhering to at least one surface of a thermoplastic polyimide film to form a laminate.

Accordingly, the teachings of Chen et al. or Shiotani et al. combined with JP '966 do not teach or suggest the features of claim 1.

### **Independent Claim 2**

Independent claim 2 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. Independent claim 2 recites similar features to claim 1 in that claim 2 requires forming at least one conductor layer directly adhering to at least one of the thermoplastic polyimide surfaces to obtain a laminate, and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced. Accordingly, the arguments made with respect to claim 1 above also apply to claim 2.

Claim 2 further requires the features of casting or applying a polyamic acid corresponding to a thermoplastic polyimide to at least one of a sheet material surface, and imidating said polyamic acid to form a polyimide laminate having a thermoplastic polyimide surface. Thus, claim 2 requires formation of a polyimide laminate having a thermoplastic polyimide surface, so as to form at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces.

Shiotani et al. teaches formation of a polyimide/polyimide composite sheet upon which a metal film (metal foil) is fixed (see column 5, lines 44-48) by a hot melt method. Shiotani et al. fails to teach or suggest forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces.

Similarly, Chen et al. teaches formation of a thermoplastic polyimide by use of a solution of a precursor applied onto a first film of polyimide, followed by heating to complete imidization (column 3, lines 9-27). Chen et al. teaches that a metal sheet or foil is laminated thereafter onto the thermoplastic polyimide film (column 3, lines 28-30). Thus, Chen et al. does not teach or suggest forming a conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces to obtain a laminate.

JP '966 is directed to a method of cast-coating a solution of a heat-resistant polymer solution on a metal foil and then solidifying via drying to produce a flexible composite sheet. After solidification via drying, JP '966 teaches a ripening step. Thus, like Chen et al. and Shiotani et al., JP '966 fails to provide any teaching or suggestion of forming at least one

conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces to obtain a laminate.

For these reasons, and the reasons discussed above with respect to claim 1, the combination of Chen et al., Shiotani et al. and JP '966 fails to teach or suggest the features of claim 2.

### **Independent Claim 3**

Independent claim 3 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. Independent claim 3 recites similar features to claim 1 in that claim 3 requires forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces, and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced. Accordingly, the arguments made with respect to claim 1 above also apply to claim 3.

Claim 3 further requires the limitation of attaching at least one thermoplastic film to at least one of a sheet material surface to form a polyimide laminate having thermoplastic polyimide surface(s). The teachings of Chen et al., Shiotani et al. and JP '966 fail to teach or suggest the features required by claim 3. In particular, claim 3 requires formation of a polyimide laminate having a thermoplastic polyimide surface(s), and onto which at least one conductor layer is formed directly adhering with at least one of the thermoplastic polyimide surface(s). Because the combination of references fails to teach forming at least one conductor layer directly

adhering with at least one of the thermoplastic polyimide surfaces, the combination would also fail to teach or suggest heating said laminate so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced.

**Independent Claim 17**

Independent claim 17 is directed to a process for producing a laminate which comprises dry plating at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate. None of the cited references teaches or suggests this required feature of claim 17. That is, all of the cited references are directed to processes which employ metal foils. The only mention of plating in the cited references appears to be the one mentioned in the Background of the Invention of Shiotani et al. at column 1, lines 29 and 30 which mentions that it has been known that a metal is electrically plated onto a polyimide film. The invention of Shiotani et al., however, employs a metal foil. Chen et al. and JP '966 also employ metal foils. Accordingly, for at least this reason, the combination of references fails to render claim 17 unpatentable.

Claim 17, however, further requires heating said laminate so that the adhesive strength between the thermoplastic polyimide film and the conductor layer is enhanced. As noted above, the teachings of JP '966 would not have motivated one of ordinary skill in the art to further heat the laminate because such heat aging taught by JP '966 reduces adhesion strength.

**Independent Claim 18**

Independent claim 18 is directed to a process for producing a laminate. The process comprises providing a thermoplastic polyimide film having at least one surface. The process further requires forming a conductor layer directly adhering with said at least one surface. Claim 18 further requires heating the thermoplastic polyimide film and the formed conductor layer. The combination of references fails to teach or suggest the features required by claim 18.

With respect to providing a thermoplastic polyimide film having at least one surface and forming a conductor layer directly adhering with said at least one surface, it is noted that the Background of the Invention of Shiotani et al. teaches that it was known to electrically plate metal onto a polyimide film. However, Shiotani et al. does not teach or suggest a subsequent step of heating the thermoplastic polyimide film and the formed conductor layer. The teachings of Shiotani et al. would have directed one of ordinary skill in the art away from use of electrically plating. The method of Shiotani et al. would have motivated one of ordinary skill in the art to employ a metal film or metal foil which is fixed onto the polyimide coat of the polyimide/polyimide composite sheet by a hot melt method. Similarly, the teachings of Chen et al. and JP '966 would have motivated one of ordinary skill in the art to employ a metal foil, in contrast to the required step of claim 18 of forming a conductor layer directly adhering with said at least one surface.

Accordingly, the combination of art applied by the Examiner fails to teach or suggest the features required by claim 18.

**2. Claims 1, 3-11, 13 and 17-20 are patentable over JP '640 or JP '106 in combination with JP '966.**

The combination of references set forth in the rejection fails to raise a prima facie rejection of the claims because the combination does not teach all of the features required by the claims. Furthermore, a combination of the references provides no suggestion which would have rendered the claimed invention obvious.

In JP '640, Examples 1-8 employ a copper foil wherein heat and pressure are applied. Example 9 of JP '640, on the other hand, provides a conductor layer which is directly formed by a chemical plating method. Example 9 of JP '640 does not disclose or suggest that a heating step is performed after chemical plating is conducted. Thus, JP '640 does not teach sputtering or vapor depositing a metal on a thermoplastic polyimide sheet followed by heating. This is clearly evident from Table 1 which does not report a press temperature for Example 9, as compared with the other examples which all report a press temperature when laminating a foil onto a thermoplastic polyimide.

JP '106 merely teaches direct lamination of metal or metal oxide onto a heat resistant film. A reading of the machine translation of JP '106 shows that the drying and heating steps pertain to formation of the polyimide film itself prior to formation of metal or metal oxide. Furthermore, JP '106 discloses a non-thermoplastic polyimide layer, not a thermoplastic

polyimide as required by the present claims. This is evident from the disclosed heat treatment carried out as high as 480°C for four minutes.

As acknowledged by the Examiner, JP '640 and JP '106 each fail to teach heating the laminate. JP '966 was applied for its disclosure of aging to allegedly render the claimed heating step obvious. As noted in the above discussion of JP '966, this teaching is directed to aging of a polyimide which is formed on a metal foil. This teaching would not have motivated one of ordinary skill in the art to modify the teachings of either JP '640 or JP '106 in the manner asserted by the Examiner.

#### **Independent Claim 1**

Independent claim 1 requires heating said laminate after said laminate is formed so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced. Accordingly, the combination of references would not teach or suggest this step. That is, JP '966 does not teach any enhancement of adhesion. The mere fact that JP '966 may not mention a reduction in adhesion strength in some sections does not mean that JP '966 would be considered to describe that adhesion strength is enhanced.

The Examiner argues that it would have been obvious to combine the teachings of references "with the expectation of achieving a superior bond between the polyimide and the metal layers." However, the Examiner's conclusion is not supported by the teachings of the cited references. JP '966 actually teaches that adhesion strength was reduced by about 20% in its



Example 1 compared with that prior to heat aging. In no way would one of ordinary skill in the art expect achieving a superior bond as asserted by the Examiner.

JP '966 is directed to a method which comprises cast-coating, on a metal foil, a solution of a heat-resistant polymer, a polyimide precursor solution, or a polyester-imide solution, then solidifying the solution via drying, and thereafter executing a ripening for a prolonged period. Thus, instead of directly forming a metal on a thermoplastic polyimide as required by the present claims, JP '966 is directed to forming a plastic layer on a metal foil. This teaching would not have motivated one of ordinary skill in the art to modify the teachings of JP '640 or JP '106 to employ a heating step as required by the present claim 1.

Accordingly, claim 1 is patentable over the combination of art applied by the Examiner.

### **Independent Claim 2**

Independent claim 2 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. Independent claim 2 recites similar features to claim 1 in that claim 2 requires forming at least one conductor layer directly adhering to at least one of the thermoplastic polyimide surfaces to obtain a laminate, and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced. Accordingly, the arguments made with respect to claim 1 above also apply to claim 2.

Claim 2 further requires the features of casting or applying a polyamic acid corresponding to a thermoplastic polyimide to at least one of a sheet material surface, and imidating said

polyamic acid to form a polyimide laminate having a thermoplastic polyimide surface. Thus, claim 2 requires formation of a polyimide laminate having a thermoplastic polyimide surface, so as to form at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces.

As noted above with respect to the argument pertaining to claim 1, JP '640 and JP '106 both fail to teach or suggest a subsequent heating step. Contrary to the assertion of the Examiner, JP '966 would not have motivated one of ordinary skill to modify either JP '640 or JP '106 to perform a subsequent heating step. Even if the references could be combined, the combination would suggest a decrease in adhesion strength, not an enhancement of adhesion as required by claim 2.

Accordingly, the combination of art does not render claim 2 unpatentable.

### **Independent Claim 3**

Independent claim 3 is directed to a process for producing a laminate comprising a polyimide, a sheet material and a conductor layer. Independent claim 3 recites similar features to claim 1 in that claim 3 requires forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces, and heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced. Accordingly, the arguments made with respect to claim 1 above also apply to claim 3.

**Independent Claim 17**

Independent claim 17 is directed to a process for producing a laminate which comprises dry plating at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate, and heating said laminate so that the adhesive strength between the thermoplastic polyimide film and the conductor layer is enhanced.

As acknowledged by the Examiner, each of JP '640 and JP '106 fails to teach a heating step after a laminate is formed. JP '966 is applied by the Examiner to allegedly render the claimed heating obvious.

As noted above, JP '966 would not have motivated one of ordinary skill in the art to modify the teachings of JP '640 or JP '106 to employ a heating step as claimed. Since JP '640 and JP '106 each form a metal on a polyimide, one of ordinary skill would not look to the teachings of JP '966 which is concerned with formation of polyimide on a metal foil. That is, there is no reason to look to the teachings of JP '966 because a polyimide is already formed in JP '640 or JP '106 when metal is applied. Furthermore, the teaching of JP '966 that a reduction of adhesive strength would be expected does not suggest heating so that adhesive strength is enhanced. Therefore, the combination does not teach or suggest the features of claim 17.

**Independent Claim 18**

Independent claim 18 is directed to a process for producing a laminate. The process comprises providing a thermoplastic polyimide film having at least one surface. The process

further requires forming a conductor layer directly adhering with said at least one surface. Claim 18 further requires heating the thermoplastic polyimide film and the formed conductor layer. The combination of references fails to teach or suggest the features required by claim 18.

As noted above, there is no reason why one of ordinary skill in the art would look to the teaching of JP '966 when a polyimide has already been formed in the processes of JP '640 and JP '106. Furthermore, there would have been no motivation to look to the teachings of JP '966 as one would expect heating to have an adverse effect on adhesion. Accordingly, claim 18 is patentable over the combination of references,

**3. Claim 12 is patentable over JP '640, Chen et al., Shiotani et al. or JP '106 in combination with JP '966 further in combination with Ameen et al.**

Claim 12 further recites the feature of increasing the total thickness of the conductor layer a wet plating method. Claim 12 depends from claim 10, which requires that the conductor layer is formed by a dry plating method. Claim 10 depends from any one of claims 1 to 3.

The arguments with respect to the patentability of claims 1-3 are incorporated herein.

As acknowledged by the Examiner, JP '640 and JP '106 each do not teach a heating step as recited in any of claims 1 to 3. The teachings of JP '966 would not have motivated one of ordinary skill in the art to modify JP '640 or JP '106 to employ a heating step after metal is formed on polyimide. Furthermore, there is no teaching or suggestion which would lead one of

ordinary skill in the art to expect an enhancement of adhesion strength because JP '966 does not teach any enhancement of adhesion strength, but instead teaches a reduction.

Similarly, a combination of Chen et al. or Shiotani et al. with JP '966 would not suggest the invention recited in any of claims 1 to 3. None of the references in the combination would motivate one of ordinary skill in the art to form at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate because each of the references employs metal foil. Furthermore, the teachings of JP '966 do not suggest any enhancement of adhesion strength, but instead teach a reduction.

Ameen et al. fails to provide the teachings which the primary references lack.

Accordingly, the combinations of references do not render claim 12 unpatentable.

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Attorney Docket No. **010164**  
Application No. **09/782,169**

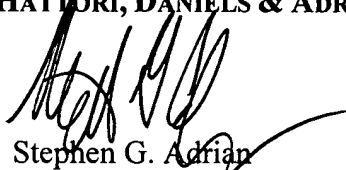
**(VIII) CONCLUSION**

For the above reasons, the Honorable Board is requested to reverse the rejections of the Examiner.

If this paper is not timely filed, appellants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to Deposit Account No. 50-2866, along with any other additional fees that may be required with respect to this paper.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read 'Stephen G. Adrian', is written over the printed name.

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SGA/arf

**(IX) CLAIMS APPENDIX**

1. (Previously Presented) A process for producing a laminate comprising a polyimide and a conductor layer, which comprises

forming at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate, and

heating said laminate after said laminate is formed so that the adhesion strength between the thermoplastic polyimide film and the conductor layer is enhanced.

2. (Previously Presented) A process for producing a laminate comprising a polyimide, a sheet material and a conductor layer, which comprises

casting or applying a polyamic acid corresponding to a thermoplastic polyimide to at least one of a sheet material surface,

imidating said polyamic acid to form a polyimide laminate having a thermoplastic polyimide surface,

forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces to obtain a laminate, and

heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced.

3. (Previously Presented) A process for producing a laminate comprising a polyimide, a sheet material and a conductor layer comprises

attaching at least one thermoplastic film to at least one of a sheet material surface to form a polyimide laminate having thermoplastic polyimide surface(s),

forming at least one conductor layer directly adhering with at least one of the thermoplastic polyimide surfaces, and

heating said laminate so that the adhesion strength between the thermoplastic polyimide and the conductor layer is enhanced.

4. (Original) The process according to claims 2 or 3, wherein said sheet material is a non-thermoplastic polyimide film.

5. (Original) The process according to any one of claims 1 to 3, wherein the thickness of said conductor layer is from 0.01 to 5  $\mu\text{m}$ .

6. (Original) The process according to any one of claims 1 to 3, wherein the heating temperature is 50°C or higher.



7. (Original) The process according any one of claims 1 to 3, wherein the heating temperature is higher by 30°C or more than the glass transition temperature of the thermoplastic polyimide.

8. (Previously Presented) The process according to any one of claims 1 to 3, wherein said heating step is carried out under pressure.

9. (Original) The process according to claim 8, wherein the pressure at the pressurizing is 1MPa or more.

10. (Previously Presented) The process according to any one of claims 1 to 3, wherein said conductor layer is formed by a dry plating method.

11. (Original) The process according to claim 10, wherein said dry plating method is one selected from a group consisting of sputtering method, vacuum evaporation method, ion plating method and chemical evaporation method.

12. (Original) The process according to claim 10, which further comprises increasing the total thickness of the conductor layer by a wet plating method.

13. (Original) The process according to any one of claims 1 to 3, wherein said conductor layer comprises copper.

14 – 16 (Canceled)

17. (Previously Presented) A process for producing a laminate comprising:  
dry plating at least one conductor layer directly adhering with at least one surface of a thermoplastic polyimide film to obtain a laminate, and  
heating said laminate so that the adhesive strength between the thermoplastic polyimide film and the conductor layer is enhanced.

18. (Previously Presented) A process producing a laminate comprising:  
providing a thermoplastic polyimide film having at least one surface;  
forming a conductor layer directly adhering with said at least one surface; and  
heating the thermoplastic polyimide film and the formed conductor layer.

19. (Previously Presented) The process according to any one of claims 1 to 3 or 17, wherein said laminate has a peel strength of at least 1.0 N/cm prior said heating.

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20. (Previously Presented) The process according to claim 18, wherein said conductor directly adheres with said at least one surface with a peel strength of at least 1.0 N/cm prior to said heating.

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**(X) EVIDENCE APPENDIX**

Declarations of Masaru Nishinaka were filed and entered into the record on July 11, 2003 and on March 2, 2005, providing experimental data in addition to that provided in the specification. The declaration highlights the differences between the present invention and prior art methods. A copy of the declarations is attached to complete the record.

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**(XI) RELATED PROCEEDINGS APPENDIX**

n/a